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REMARKS

Claims 1-24 and 27-31 remain pending.

In the Office Action, the Examiner rejected claims 1-13, 15, and 27-31 as being unpatentable over Goodson et al. (U.S. Patent No. 6,942,018) in view of Chrysler et al. (U.S. Patent No. 4,765,397); rejected claims 14 and 19-22 under 35 U.S.C. § 103(a) as being unpatentable over Goodson et al. in view of Chrysler et al. and further in view of Tuckerman et al. (U.S. Patent No. 4,450,472); rejected claims 16-18 under 35 U.S.C. § 103(a) as being unpatentable over Goodson et al. in view of Chrysler et al. and further in view of Crowe (U.S. Patent No. 4,944,344); and rejected claims 23 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Goodson et al. in view of Chrysler et al. and further in view of Tuckerman et al. and still further in view of Crowe.

Claims 1-13, 15, and 27-31:

Applicants respectfully traverse the 35 U.S.C. § 103(a) rejection of claims 1-13, 15, and 27-31 over Goodson et al. in view of Chrysler et al.

I. No Suggestion or Motivation:

A *prima facie* case of obviousness has not been established, because no evidence has been provided that one of ordinary skill would have been motivated to add the teachings of Chrysler et al. to Goodson et al. Only a bare conclusion of "to increase the channel density in proportion to cooling needs of [the] integrated circuit chip" has been alleged, which is legally insufficient to

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establish a *prima facie* case. No facts or other evidence of a suggestion or motivation has been provided in the stated rejection on pages 4-8 of the Final Office Action.

Further, Goodson et al. already teaches increasing channel density at col. 15, lines 1-5. This teaching of Goodson et al. cannot logically suggest or motivate adding a feature that the reference admittedly lacks. No need or deficiency in Goodson et al. has been identified that would motivate the addition of teachings from Chrysler et al.

A. Examiner's response:

On pages 2 and 3 of the Office Action, the Examiner attempts to factually support the stated rejection, as he should have done in the first instance. See M.P.E.P. § 2142. To paraphrase, the Examiner: 1) contends that Goodson et al. and Chrysler et al. are both “in the field of applicant’s invention,” 2) states several teachings from the references, and 3) concludes without further elaboration that the suggestion or motivation to combine “is within both prior art references which is to vary the channel size to maximize the cooling of the integrated circuit chip.”

B. Applicants' reply:

These contentions are insufficient to show motivation or suggestion to combine two references. Instead they amount to a “can be combined” argument. It is clear legal error to rely solely on such an argument. See M.P.E.P. § 2143.01(III) (“Fact That References Can Be Combined Or Modified Is Not Sufficient To Establish Prima Facie Obviousness”).

What the Examiner has not shown is the *desirability* of the specific combination proposed. See M.P.E.P. § 2143.01(I) for the legal standard. As Applicants explained before,

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Goodson et al. already teaches increasing channel density at col. 15, lines 1-5. Given that Goodson et al. already teaches one scheme for increasing channel density, why would one of ordinary skill in the art have been motivated to look elsewhere (and specifically to Chrysler et al.) to add the specific teachings in the secondary reference? This is the central question of

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